



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,615	03/16/2004	Byung Mo Yoon	YOON3009/JEK	9678
23364 7590 09/10/2007 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			EXAMINER SPAHN, GAY	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,615	Applicant(s) YOON, BYUNG MO	
	Examiner Gay Ann Spahn	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claim 3 is withdrawn in view of the newly discovered references to GANDY ET AL. (U.S. Patent No. 5,617,688) and MACLEOD (U.S. Patent No. 4,765,110). Rejections based on the newly cited references follow.

Drawings

The drawings are objected to because:

(1) Fig. 2 is actually three separate figures, the main exploded view figure on the right-hand side of the page which must have a bracket inserted to embrace separated parts (see 37 CFR 1.84(h)(1)) and two detailed views on the left-hand side and therefore, each of the figures should be given its own figure legend and number and there should not be any arrows connecting the views, but rather the dashed circles on sub-panel (30) and main panel (15) on the right-hand side should be labeled with Roman or Arabic numerals which indicates where the detailed view can be found (see 37 CFR 1.84(h)(3));

(2) Fig. 3 is actually two separate figures, the main view figure on the right-hand side of the page and one detailed view on the left-hand side and therefore, each of the figures should be given its own figure legend and number and there should not be any arrows connecting the views, but rather the dashed circle on the right-hand side should

be labeled with Roman or Arabic numerals which indicates where the detailed view can be found (see 37 CFR 1.84(h)(3));

(3) Fig. 3, section line A-A must be changed to 4-4 or IV-IV in both the drawings and specification in accordance with 37 C.F.R. 1.84(h)(3); and

(4) all of Figs. 1-4 use lead lines ending in arrows and the examiner notes that if the arrows are not in accordance with 37 CFR 1.84(r)(1)-(3), then the arrows should be deleted.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. (Emphasis added).

The abstract of the disclosure is objected to because:

(1) the amended Abstract filed on 16 MARCH 2004 is incorrect in that Applicant did not keep the heading with the amended paragraph and the heading needs to be changed from "ABSTRACTS" to --ABSTRACT-- or --ABSTRACT OF THE DISCLOSURE--;

(2) the reference numerals or characters must either be within parentheses or deleted;

(3) the words "This invention" can be implied and should be deleted; and

(4) the second sentence of the Abstract does not appear to be narrative in form (i.e., short, concise sentences), but rather appears to be in claim format (one, long run-on sentence).

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

(1) on page 4 of the Preliminary Amendment filed on 16 MARCH 2004, in the "Amendments To Specification" section, the amendment to the second paragraph on page 2, line 10, "the holes 20" was changed to "the holes 37", but there is no reference numeral "37" in the drawings and so this should be reamended to --the second holes 37a, 37b--.

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

Claims 1-4 are objected to because of the following informalities:

(1) **claims 1-4**, according to the Manual of Patent Examining Procedure (MPEP) § 608.01(m), entitled "Form of Claims", it is Office Practice to insist that each claim must be the object of a sentence starting with "I (or we) claim:", "The invention claimed is:" or equivalent and therefore, on page 9, line 1, the word "CLAIMS" should be changed to --I claim:-- or equivalent;

(2) **claim 2**, line 4, and **claim 3**, line 4, the recitation of "sub" should be changed to --sub panel-- as this was miscopied from the Preliminary Amendment filed on 16 MARCH 2004;

Art Unit: 3635

(3) **claim 2**, lines 10-11, and **claim 3**, lines 10-11, the recitation of “a corresponding first holes” is grammatically incorrect and should be changed to --a corresponding first hole--;

(4) **claim 2**, line 16, after “wherein” the word --the-- should be inserted; and

(5) **claim 2**, lines 17-18, the recitation of “so that the second strips of the sub panel be inserted in a recess” is grammatically incorrect and the word “be” should be changed to --are--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, lines 16-19, the recitation of “wherein upper and lower edge plates of the main panel have recesses adapted to cooperate with the first strips so that the second strips of the sub panel be inserted in a recess when a sub panel is joined to an upper or lower end of the main panel” is vague, indefinite, and confusing as lacking antecedent basis and as not being fully understood for lack of clarity.

Art Unit: 3635

First, in line 16, the recitation of "wherein upper and lower edge plates" lacks antecedent basis because it is not clear if these are the same upper and lower edge plates introduced in line 15 and therefore the examiner suggests inserting the word --the-- or --said--, after the word wherein.

Second, the recitation of "wherein upper and lower edge plates of the main panel have recesses adapted to cooperate with the first strips" is not understood. If the first strips are the structure presented by reference numeral 55, then it is not clear if the "recesses" are the structure represented by reference numeral 70, the structure represented by reference numeral 72 or some combination of the structures represented by reference numerals 70 and 72?

Third, it is not clear how either of the recesses (70 or 72) "cooperate" with the first strips (55)?

Fourth, while the examiner understands that the second strips (60) of the upper and lower sub panels (30, 40) fit in the recesses (70 - dashed lines in bottom detailed view on left-hand side of Fig. 2), the recitation of "so that the second strips of the sub panel be inserted in a recess when a sub panel is joined to an upper and lower end of the main panel" lacks antecedent basis as follows. Is "a recess" intended to refer back to one of the recesses introduced in line 17 or is it a new recess being introduced? Is "a sub panel" intended to refer back to the sub panel already introduced or is it a new sub panel? Is "an upper and lower end" intended to refer back to the upper and lower end of the main panel already introduced or is it a new upper and lower end?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over GANDY ET AL. (U.S. Patent No. 5,617,688) in view of MACLEOD (U.S. Patent No. 4,765,110).

As to claim 3, GANDY ET AL. disclose a decoration panel (11) adapted to be installed on walls, comprising:

a main panel (12 in Figs. 1-3) having a plurality of first holes (54, 54) aligned along the upper or lower part of the panel (12) in the vertical direction,

at least one sub-panel (13 or 14) having a front cover (32) and a plurality of second holes (45, 46) on the rear (34, 36, 30) of the front cover (32) corresponding in spacing to the first holes (54, 54) and being provided on the upper or lower ends (see Fig. 1) of the main panel (12), and

at least one joiner (57) being engaged through the second holes (45, 46) of the sub-panel (13 or 14) into the first holes (54, 54) of the main panel (12) to join the sub-panel (13 or 14) to the upper or lower part of the main panel (12),

said decoration panel (11) having a length that is adjustable by selectively inserting the at least one joiner (57) through one of the second holes (46, 46) of the sub-panel (13 or 14) and into a corresponding first hole (54) of the main panel (12).

GANDY ET AL. fail to explicitly disclose a plurality of horizontal score lines are formed on the upper part or lower part of the main panel so that the length of the main panel may be adjusted by cutting the upper part or lower part of the main panel along respective score lines.

MACLEOD discloses a panel (22 in Fig. 15) which has a plurality of horizontal score lines (200) formed on the upper or lower part thereof so that the length of the panel may be adjusted by bending and snapping along the score lines to take of sections.

The examiner notes that the recitation of "by cutting" is a method limitation and since the resulting structure is the same whether the section is removed at the score line by cutting or by bending and snapping, this limitation is considered to be met by MACLEOD.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the panel of GANDY ET AL. by including the plurality of score lines of MACLEOD in order to be able to adjust the length of the overall panel as needed.

Allowable Subject Matter

Claim 2 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 2-4 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent cited of interest as shown various decoration panels include: U.S. Patent Nos. 5,347,782, 5,430,986, and 5,924,225 all to Vagedes; U.S. Patent No. 6,122,875 to Schiedegger et al.; U.S. Patent No. 4,251,966 to Foltman; and U.S. Patent No. 5,524,407 to Ricard et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone

Art Unit: 3635

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

^{GAS}
Gay Ann Spahn, Patent Examiner
September 1, 2007


RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER